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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/200,657	11/25/98	HEIN	M TSRI-184.200

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EXAMINER

HAAS, T

ART UNIT

1649

PAPER NUMBER

9

DATE MAILED: 11/23/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/200,657**

Applicant(s)  
**Hein et al.**

Examiner  
**Thomas Haas**

Group Art Unit  
**1649**



☒ Responsive to communication(s) filed on 13 Sep 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 and 21-78 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 43-78 is/are allowed.

☒ Claim(s) 1, 21-30, and 39-41 is/are rejected.

☒ Claim(s) 31-38 and 42 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claims 21-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 21-30 read on transgenic plant cells comprising nucleic acid sequences encoding any multimeric protein. The specification of the instant application specifically describes the production of transgenic plant cells comprising nucleic acid sequences encoding immunoglobulin light and heavy chains. It is not clear from this description as to whether or not the inventor was in possession of the invention as claimed (*University of California v, Eli Lilly*, 43 USPQ2d 1398 (Fed. Cir. 1997)). Limitation to specific examples disclosed in warranted where unique and unpredictable biochemical and genetic actions are involved. The scope of the claimed invention is not commensurate with the disclosure as filed. See *In re Marzocchi*, 169 USPQ 367; *In re Angstadt and Griffin*, 190 USPQ 214; *Ex parte Hitzeman*, 9 USPQ2d 1821.

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### ***Claim Objections***

2. Claims 31-38 and 42 are objected to because each of these claims depends upon a rejected claim. Appropriate correction is required.

### ***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 1 remains provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application Nos. 08/642,406 and 09/200,657. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Conclusion***

5. Claims 43-78 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Haas whose telephone number is (703) 305-7270. The examiner can normally be reached on Mon.-Fri. from 7:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



**GARY BENZION**  
**PRIMARY EXAMINER**